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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/565,125

01/19/2006

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P29168

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7055 7590 02/09/2009  
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EXAMINER

BERNATZ, KEVIN M

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

02/09/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/565,125 | <b>Applicant(s)</b><br>TAKAI ET AL. |  |
|                              | <b>Examiner</b><br>Kevin M. Bernatz  | <b>Art Unit</b><br>1794             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/26/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicants' election with traverse of Group II, species i (claims 3 and 4) in the reply filed on December 1, 2008 is acknowledged. The traversal is on the ground(s) that the restriction is improper because the Examiner failed to address 1.475(b)(1) (*page 3 of response*). This is not found persuasive because the Examiner notes that 1.475(b) is *not* in the alternative to 1.475(a), but that 1.475(a) and 1.475(b) must **both be met** to satisfy unity of invention. Since 1.475(a) is not met for the reasons presented previously, whether 1.475(b) is met or not is moot, since unity of invention fails due to the failed meeting of 1.475(a). The requirement is still deemed proper and is therefore made FINAL.

### *Specification*

2. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.

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(d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.

(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.

(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

***The abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 150 words (37 CFR 1.72). See MPEP § 608.01(b).***

The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 3 and 4 are rejected under 35 U.S.C. 102(a), (b) and/or (e) as being anticipated by Ishida et al. (U.S. Patent No. 6,347,016 B1 and/or WO 98/03972).

Regarding claim 3, Ishida et al. disclose a magnetic recording medium stamper where a concave/convex pattern for manufacturing a discrete track magnetic recording medium is formed (*Figure 20 and relevant disclosure thereto*) and a stamper center specifying mark capable of specifying a center of the stamper is formed (*col. 28, lines 51 – 60*).

Regarding claim 4, Ishida et al. disclose a center specifying mark as either a concave or concave part meeting the claimed limitations (*col. 28, lines 51 – 60*).

6. Claims 3 and 4 are rejected under 35 U.S.C. 102(a), (b) and/or (e) as being anticipated by Takemoto et al. (U.S. Patent No. 6,351,449 B1).

Regarding claim 3, Takemoto et al. disclose a magnetic recording medium stamper where a concave/convex pattern for manufacturing a discrete track magnetic recording medium is formed (*Figures 5, 14 and 15 and relevant disclosure thereto and col. 5, lines 27 – 39*) and a stamper center specifying mark capable of specifying a center of the stamper is formed (*col. 6, line 53 bridging col. 7, line 6*).

Regarding claim 4, Takemoto et al. disclose a center specifying mark as either a concave or concave part meeting the claimed limitations (*col. 6, line 53 bridging col. 7, line 6*).

7. Claims 3 and 4 are rejected under 35 U.S.C. 102(a), (b) and/or (e) as being anticipated by Kashihara et al. (U.S. Patent No. 4,472,124).

Regarding claim 3, Kashihara et al. disclose a magnetic recording medium stamper where a concave/convex pattern for manufacturing a discrete track magnetic recording medium is formed (*Abstract and col. 3, lines 35 - 52*) and a stamper center specifying mark capable of specifying a center of the stamper is formed (*Abstract; col. 3, lines 33 – 52; and Figures*).

Regarding claim 4, Takemoto et al. disclose a center specifying mark as either a concave or concave part meeting the claimed limitations (*Abstract; col. 3, lines 33 – 52; and Figures*).

8. Claims 3 and 4 are rejected under 35 U.S.C. 102(a) and/or (e) as being anticipated by Umada et al. (U.S. Patent App. No. 2005/0048154 A1 and/or WO 03/083854 A1). See US '154 A1, which is the English language equivalent of WO '854 A1.

Regarding claim 3, Umada et al. disclose a magnetic recording medium stamper where a concave/convex pattern for manufacturing a discrete track magnetic recording medium is formed (*Figures and Abstract*) and a stamper center specifying mark capable of specifying a center of the stamper is formed (*ibid*).

Regarding claim 4, Takemoto et al. disclose a center specifying mark as either a concave or concave part meeting the claimed limitations (*Figures and Abstract*).

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kevin M. Bernatz whose telephone number is (571) 272-1505. The Examiner can normally be reached on M-F, 8:30 AM - 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin M. Bernatz/  
Primary Examiner, Art Unit 1794

January 28, 2009